

Appl. No. 09/890,919  
Atty. Docket No. CM2034  
Amdt. dated 03/23/2004  
Reply to Office Action of 10/23/2003  
Customer No. 27752

### REMARKS

Claims 1-13 are pending in the present application. No additional claims fee is believed to be due.

Rejection Under 35 USC 103(a) Over Shana'a (WO 94/03150) in view of Ilardi et al. (6,322,799) in view of the Handbook of Cosmetic Science and Technology

Claims 1-13 have been rejected under 35 USC 103(a) as being unpatentable over Shana'a.

Shana'a discloses compositions for washing the human body which deliver oil components to the skin or hair. The compositions comprise (a) an oil component, (b) one or more nonionic sugar-based surfactants said surfactant being present in weight excess over the oily component, and (c) a water soluble cationic polymer.

Ilardi discloses compositions which can be leave-on skin care compositions or personal wash compositions, which comprise 0 to 90% surfactant and 1 to 25% of a mixture of short and long chain alpha-hydroxy acid esters.

The instant compositions, on the other hand, are leave-on cosmetic compositions comprising:

- a) from about 6% to about 20% of a polyhydric alcohol; and
- b) a cation containing polymer selected from the group consisting of cationic, basic, amphoteric and zwitterionic polymers and mixtures thereof;

wherein said composition comprises less than 4% of an anionic, zwitterionic or amphoteric surfactant and from about 0.01% to about 1.0% of C<sub>8</sub> to C<sub>24</sub> mono, -di and -tri acyl sugar esters

Shana'a is entitled "Washing Composition". Such compositions are specific to compositions formulated to be washed off the skin. For this reason the compositions are different from the leave-on compositions of the present invention. For example, all compositions of Shana'a must have surfactant present in excess of any oily component. As is well known in the art, surfactants are used to remove unwanted materials from surfaces. In order to accomplish this function, the surfactants must be present in sufficient quantities to break the bond between the surface to be cleansed and the unwanted material. In the instant invention, very small quantities of surfactant, which must include from about 0.01% to about 1.0% of C<sub>8</sub> to C<sub>24</sub> mono, -di and -tri acyl sugar esters, is used to improve the stability and skin feel of the compositions. Not only are the levels of surfactant different, but the sugar based surfactants taught in Shana'a have shorter alkyl chains for enhancing foaming. This foaming is critical to successful wash-off compositions, but is undesirable in a leave-on skin care composition.

The Office action states that Shana'a "lacks an exemplification of the instant invention wherein the sugar ester (the alkyl polysaccharide) comprises 0.01-1% of the composition and additional surfactants". Applicants assert that such a composition would have been outside the

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Shana'a disclosure and certainly would not function as a washing composition, since 4% surfactant would not be sufficient to produce acceptable cleansing.

The Office Action combines the Shana'a reference with Ilardi, which discloses leave-on skin care compositions and personal washing compositions. The Office Action states: "...because Bardi (sic) et al. teach that the amount of nonionic surfactants, such as the alkyl polysaccharides taught by Shana (sic) can be varied between 0-10% in washing compositions; c) because it has been held that where the general conditions of a claims are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art."

However, while alkyl polysaccharide surfactants are listed in the Shana'a reference, there would be no motivation to substitute these compounds into the Ilardi compositions, nor to raise the level of surfactants in Shana'a based on the disclosure of Ilardi. Shana'a teaches away from the instant compositions by requiring more surfactant than oily component in its compositions. Following this insistence on higher levels of surfactant, where is the motivation in Ilardi to decrease them? Also, regardless of the relative mildness of anionic surfactants, Applicants acknowledge that their use is known as is stated in The Handbook of Cosmetic Science and Technology".

To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in knowledge generally available to one of skill in the art, to modify the reference or to combine references. Where is the motivation provided by Ilardi to decrease the amount of surfactant used in Shana'a? Would combining the disclosure of a washing composition and a reference requiring mixtures of  $\alpha$  hydroxy acid esters and 0 to 90% surfactants, not be more likely to produce a washing composition according to Shana'a which also contains the  $\alpha$  hydroxy acid esters? Second, there must be a reasonable expectation of success. Would the combined Shana'a, Ilardi and "Handbook of Cosmetic Science and Technology" disclosures suggest a successful attempt, in the specific claimed compositions of the instant invention, at using of small amount of about 0.01% to about 1.0% of  $C_8$  to  $C_{24}$  mono, -di and -tri acyl sugar esters to improve stability and skin feel? Applicants do not believe so.

Finally, the prior art reference(s) must teach or suggest all claim limitations. Applicants assert that, while polyhydric alcohols may be optional in the references, there is no inclusion of these materials nor contemplation of the range in which they are used in the references. In applying a citation it is not proper to survey the entire field of the art substitute based on the presence of unrelated compounds. Such application requires motivation within the citation to make the substitution.

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Lastly, the Office Action states: "It would have been obvious to one of ordinary skill in the art at the time the invention was made to add the anionic surfactants taught by Bardi (sic) et al. into the compositions of Shana'a because of the expectation of achieving a cosmetic washing composition with improved lathering and solubility characteristics, a rich foam and excellent mildness. However, the instant composition is a leave-on skin care composition, improved lathering and a rich foam are not desirable features in a leave on composition. Therefore, such a motivation would teach away from the use of the "anionic surfactants taught by Bardi et al.".

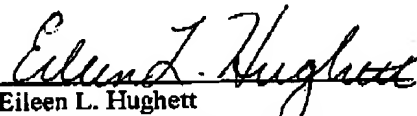
Conclusion

In light of the above remarks, it is requested that the Examiner reconsider and withdraw the rejections under 103(a). Early and favorable action in the case is respectfully requested.

Applicants have made an earnest effort to place their application in proper form and to distinguish the invention as now claimed from the applied references. In view of the foregoing, Applicants respectfully request reconsideration of this application, and allowance of Claims 1-13.

Respectfully submitted,

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